



21 SEP 1999

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Patent Cooperation Treaty Legal Office

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In re Application of	:	
BROWN et al	:	DECISION ON
Application No.: 09/117,218	:	
PCT No.: PCT/GB97/00232	:	PETITION UNDER
Int. Filing Date: 27 January 1997	:	
Priority Date: 25 January 1996	:	37 CFR 1.48(a)
Attorney Docket No.: 117-261	:	
For: TREATMENT OF NON-NEURONAL	:	
CANCER USING HSV MUTANT	:	

This is a decision on applicants' "Notice-Addition of Inventor" filed in the Patent and Trademark Office (PTO) on 11 January 1999, forwarding an executed declaration naming an additional inventor. The communication has been treated as a petition under 37 CFR 1.48(a). Pursuant to authorization therein, the required petition fee of \$130.00 (37 CFR 1.17(i)) has been charged to counsel's Deposit Account No. 14-1140.

The petition under 37 CFR 1.48(a) is **DISMISSED**, without prejudice.

BACKGROUND

On 27 January 1997, applicants filed international application No. PCT/GB97/00232 designating the United States and claiming a priority date of 25 January 1996. A Demand electing, *inter alia*, the United States, was filed prior to the expiration of 19 months from the priority date. Consequently, the deadline for entry into the national stage in the U.S. expired as of midnight of 25 July 1998.

On 24 July 1998, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, payment of the full U.S. basic national fee and surcharge fee under 37 CFR 1.492(e). A declaration was not filed.

On 09 October 1998, the PTO mailed a "Notification of Missing Requirements Under 35 U.S.C. 371" (Form PCT/DO/EO/905) requiring a declaration in compliance with 37 CFR 1.497(a)-(b). The notice set a one-month period for reply.

On 11 January 1999 (a Monday), applicants filed the present response accompanied by a two-month extension of time and an executed declaration. The declaration is executed by the inventors identified in the international application, as well as one additional inventor, i.e., Mr. John Kucharczuk. The response states that "[n]o formal petition to correct inventorship is required; see 37 CFR 1.48(f)(1)."

DISCUSSION

Contrary to applicants assertion, 37 CFR 1.48(f)(1) is not applicable to the present application. That provision, by its own terms, is limited to applications filed under 37 CFR 1.53(b). U.S. national stage applications are not filed under 37 CFR 1.53(b). Rather, correction is by way of petition under 37 CFR 1.48(a).¹

A petition under 37 CFR 1.48(a) must include: 1) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part; 2) an oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or 1.47; 3) the fee set forth in § 1.17(i); and 4) written consent of the assignee, if an assignment has been executed by any of the original named inventors.

A review of the application file reveals that applicants have satisfied items (2) and (3) above.

Applicants have not provided items (1) and (4).

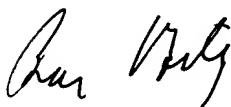
CONCLUSION

For the reasons above, the petition under 37 CFR 1.48(a) is **DISMISSED** without prejudice.

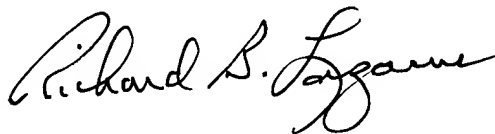
¹ This is because 35 U.S.C. 373 mandates that the PTO must refuse acceptance of any international application into the national stage if the international application was *filed* by any applicant *not qualified under Chapter 11* of that title. Pursuant to 35 U.S.C. 116, which falls under Chapter 11, joint inventors must apply for the patent jointly. The international application was not filed by the correct inventive entity. However, 35 U.S.C. 116 allows for the error to be corrected when the error occurred without deceptive intent. Accordingly, 37 CFR 1.47(a), which requires a showing that the error occurred without deceptive intent, is the appropriate avenue of relief.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.48". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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